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OFFICE OF PETITIONS

In re Application of
McKeen, et al.
Application No. 09/672,368
Filed: 28 September, 2000
Attorney Docket No.: 42390P9575

ON PETITION

This is a decision on the petitions filed on 16 October, 2002, to revive under 37 C.F.R. §1.137(b),¹ or alternatively a renewed request (under 37 C.F.R. §1.182²) to withdraw the holding of abandonment under 37 C.F.R. §1.181.³

¹ Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 C.F.R. §1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

² The regulations at 37 C.F.R. §1.182 provide:

§ 1.182 Questions not specifically provided for.

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in §1.17(h).

[47 Fed. Reg. 41278, Sept. 17, 1982, effective date Oct. 1, 1982; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997]

³ The regulations at 37 C.F.R. §1.181 provide, in pertinent part:

§1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. * * *

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. * * *

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. * * *

For the reasons set forth below:

- the petition under 37 C.F.R. §1.182 to reconsider is **GRANTED**;
- the petition considered under 37 C.F.R. §1.181 to withdraw the holding of abandonment is **GRANTED**; and
- the petition under 37 C.F.R. §1.137(b) is **DISMISSED as moot**.

BACKGROUND

A review of the record reveals:

- the instant application was filed on 28 September, 2000;
- on 17 November, 2000, the Office mailed a Notice of Missing Parts, requiring that a properly signed oath or declaration (i.e., an oath or declaration signed by all of the named inventors) be filed within two months (on or before 17 January, 2001) by the Applicants and that the missing parts surcharge of \$130.00 accompany the filing;
- it appeared that Petitioners failed to respond properly and timely to the Notice, and the application became abandoned after midnight 17 January, 2001;⁴
- no Notice of Abandonment was mailed before the Petition to Withdraw the Holding of Abandonment (styled as a "Petition to the Commissioner for Acceptance of Declaration and to Correct Office Error Under 37 C.F.R. §1.182" (sic)) on 15 November, 2001, which was considered appropriately under 37 C.F.R. §1.181 and dismissed on 29 November, 2001, for failure to make a proper showing in support of the petition;⁵
- a second petition under 37 C.F.R. §1.181 followed on 18 December, 2001, and that petition was dismissed on 22 January, 2002;
- it appears that Petitioner may have submitted by FAX a renewed petition under 37 C.F.R. §1.181 on 1 February, 2002--accompanied for the first time by a printout of Petitioner's docket reflecting matters due on 17 January, 2001, and that listing contained no reference to a

⁴ Petitioner accurately notes that First, Second and Third Status Inquiries were made on 2 February, 4 April and 27 July, 2001. However, those inquiries did not commence until weeks after the application was abandoned.

⁵ No petition fee was paid at that time. Petitioner paid only the surcharge for the late filing of the oath or declaration in response to the Notice of Missing Parts.

response due on a Notice of Missing Parts--however, that material was not received by the Office;

- a Notice of Abandonment was mailed on 25 September, 2002;
- on 16 October, 2002, Petitioner refiled via FAX that request, accompanied by a petition (with fee authorization) to revive under 37 C.F.R. §1.137(b), and included again the showing described hereinabove.

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.⁶

Accordingly, the holding of Abandonment is withdrawn, the Notice of Abandonment of 25 September, 2002, was mailed in error and is vacated, and the petition fee is waived.⁸

This application is being forwarded to OIPE for processing and then for examination in due course.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-9199.



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⁶ See: Delgar v. Schulver, 172 USPQ 513 (D.D.C. 1971).

⁸ No fee has been charged for this reconsideration.